

REMARKS

Foreign Priority:

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received.

Drawings:

The Examiner has alleged that the subject matter of the present application "admits of illustration" under 37 C.F.R. § 1.81.

Although Applicant disagrees with the Examiner and feels that one of ordinary skill in the art would understand the present invention without a figure, Applicant has taken the path of least resistance and added a Figure to address the Examiner's concerns. Applicant has also amended the specification accordingly.

Claim Amendments to Claim 1:

Applicant has amended claim 1 to clarify the claimed invention.

Specification:

The specification has been amended to correct a number of typographical errors regarding the hardness. Applicant submits that no new matter has been added as the hardness scales in claim 1 are correct.

New Claims:

Applicant has also added claims 6-90 to further claim the present invention. Applicant submits that sufficient support exists within the present specification, for each of the newly added claims.

Claim Rejections:

Claims 1-5 are all of the claims that have been examined in the present application, and currently all of these claim stand rejected.

Double Patenting Rejection:

Claim 1-5 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,634,961 to Higuchi et al. (the Parent application to the present application), claims 1-9 of U.S. Patent No. 6,602,941 to Higuchi et al., and claims 1-7 of 6,596,801 to Higuchi et al.

In view of the foregoing rejection, Applicant has taken the path of least resistance and submits herewith Terminal Disclaimers for each of the above referenced patents. Therefore, Applicant hereby requests the Examiner withdraw the above rejection. Further, Applicant hereby submits that these claims, and new claims 6-90, are allowable.

Provisional Double Patenting Rejection:

Claims 1-5 have also been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of the sister application U.S. Application No.: 10/635,610.

AMENDMENT UNDER 37 C.F.R. §1.111
Application Number 10/635,603

Our Ref: Q76678
Art Unit: 3711

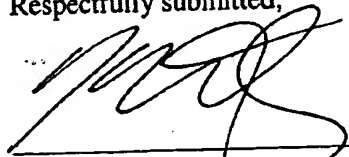
Similar to the above rejection, Applicant submits herewith a terminal disclaimer for the '610 application and submits that these claims, and claims 6-90, are allowable.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Terrance J. Wikberg
Registration No. 47,177

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: June 24, 2004



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q76678

Hiroshi HIGUCHI, et al.

Appln. No.: 10/635,603

Group Art Unit: 3711

Confirmation No.: 9575

Examiner: Raeann GORDON

Filed: August 07, 2003

For: MULTI-PIECE SOLID GOLF BALL

SUBMISSION OF TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith are Terminal Disclaimers in the above-identified application. A check in the amount of \$110.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this Submission is attached.

Respectfully submitted,

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TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned, on behalf of the petitioner, BRIDGESTONE SPORTS CO., LTD., represents that the petitioner, BRIDGESTONE SPORTS CO., LTD. is the owner of the entire right, title and interest of U.S. Application No. 10/635,610, filed on August 7, 2003 for Multi-Piece Solid Golf Ball by virtue of an Assignment from all of the inventors thereof executed on July 8, 2003, recorded on August 7, 2003 at Reel 014381, Frame 0379, as well as the entire right, title and interest in the above-captioned U.S. Application No. 10/635,603 by virtue of an Assignment from all of the inventors thereof executed on July 10, 2003, recorded on August 7, 2003, at Reel 014381, Frame 0383.

Petitioner hereby certifies that the above-mentioned Assignments have been reviewed and to the best of petitioner's knowledge and belief, title is in petitioner who is seeking to take this action.

Petitioner hereby disclaims the terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 which would extend beyond the expiration of the full statutory term as presently shortened by any terminal disclaimer of any patent issuing from U.S. Application No. 10/635,610, and hereby agrees that any patent so granted on the above-captioned U.S. Application No. 10/635,603 shall be enforceable only for and during such period

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Terminal Disclaimer
U.S. Patent Application Ser. No.: 10/635,603


Our Ref: Q76678
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that the legal title to any patent issuing from U.S. Application No. 10/635,610 shall be the same as the legal title to said patent issuing from the above-captioned U.S. Application No. 10/635,603, this agreement to run with any patent granted on the above-captioned U.S. Application No. 10/635,603 and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of any patent issuing from U.S. Application No. 10/635,610 in the event that any patent issuing from U.S. Application No. 10/635,610 later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims cancelled by a Reexamination Certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The undersigned whose signature and title appear below is empowered to act on behalf of petitioner.

Respectfully submitted,


Robert V. Sloan
Registration No. 22,775

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
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Hiroshi HIGUCHI, et al.

Appln. No.: 10/635,603

Group Art Unit: 3711

Confirmation No.: 9575

Examiner: Raeann GORDON

Filed: August 7, 2003

For: MULTI-PIECE SOLID GOLF BALL

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned, on behalf of the petitioner, BRIDGESTONE SPORTS CO., LTD., represents that the petitioner, BRIDGESTONE SPORTS CO., LTD. is the owner of the entire right, title and interest of U.S. Application No. 10/156,950, filed on May 30, 2002 for Multi-Piece Solid Golf Ball by virtue of an Assignment from all of the inventors thereof executed on May 8, 2002, recorded on May 30, 2002 at Reel 012951, Frame 0064, now issued as U.S. Patent 6,634,961 as well as the entire right, title and interest in the above-captioned U.S. Application No. 10/635,603 by virtue of an Assignment from all of the inventors thereof executed on July 10, 2003, recorded on August 7, 2003, at Reel 014381, Frame 0383.

Petitioner hereby certifies that the above-mentioned Assignments have been reviewed and to the best of petitioner's knowledge and belief, title is in petitioner who is seeking to take this action.

Petitioner hereby disclaims the terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 which would extend beyond the expiration of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,634,961, and hereby agrees that any patent so granted on the above-captioned U.S. Application No. 10/635,603 shall be enforceable only for and during such period that the legal title to U.S. Patent

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U.S. Patent Application Ser. No.: 10/635,603

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6,634,961 shall be the same as the legal title to said patent issuing from the above-captioned U.S. Application No. 10/635,603, this agreement to run with any patent granted on the above-captioned U.S. Application No. 10/635,603 and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,634,961 in the event that U.S. Patent 6,634,961 later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims cancelled by a Reexamination Certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

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Filed: August 7, 2003

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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned, on behalf of the petitioner, BRIDGESTONE SPORTS CO., LTD., represents that the petitioner, BRIDGESTONE SPORTS CO., LTD. is the owner of the entire right, title and interest of U.S. Application No. 10/156,184, filed on May 29, 2002 for Multi-Piece Solid Golf Ball by virtue of an Assignment from all of the inventors thereof executed on May 8, 2002, recorded on May 29, 2002 at Reel 012951, Frame 0152, now issued as U.S. Patent 6,602,941 as well as the entire right, title and interest in the above-captioned U.S. Application No. 10/635,603 by virtue of an Assignment from all of the inventors thereof executed on July 10, 2003, recorded on August 7, 2003, at Reel 014381, Frame 0383.

Petitioner hereby certifies that the above-mentioned Assignments have been reviewed and to the best of petitioner's knowledge and belief, title is in petitioner who is seeking to take this action.

Petitioner hereby disclaims the terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 which would extend beyond the expiration of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,602,941, and hereby agrees that any patent so granted on the above-captioned U.S. Application No.

Terminal Disclaimer
U.S. Patent Application Ser. No.: 10/635,603

Our Ref: Q76678
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10/635,603 shall be enforceable only for and during such period that the legal title to U.S. Patent 6,602,941 shall be the same as the legal title to said patent issuing from the above-captioned U.S. Application No. 10/635,603, this agreement to run with any patent granted on the above-captioned U.S. Application No. 10/635,603 and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,602,941 in the event that U.S. Patent 6,602,941 later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims cancelled by a Reexamination Certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

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Docket No: Q76678

Hiroshi HIGUCHI, et al.

Appln. No.: 10/635,603

Group Art Unit: 3711

Confirmation No.: 9575

Examiner: Raeann GORDON

Filed: August 07, 2003

For: MULTI-PIECE SOLID GOLF BALL

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned, on behalf of the petitioner, BRIDGESTONE SPORTS CO., LTD., represents that the petitioner, BRIDGESTONE SPORTS CO., LTD. is the owner of the entire right, title and interest of U.S. Application No. 10/157,492, filed on May 30, 2002 for Multi-Piece Solid Golf Ball by virtue of an Assignment from all of the inventors thereof executed on May 8, 2002, recorded on May 30, 2002 at Reel 012955, Frame 0143, now issued as U.S. Patent 6,596,801 as well as the entire right, title and interest in the above-captioned U.S. Application No. 10/635,603 by virtue of an Assignment from all of the inventors thereof executed on July 10, 2003, recorded on August 7, 2003, at Reel 014381, Frame 0383.

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Petitioner hereby disclaims the terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 which would extend beyond the expiration of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,596,801, and hereby agrees that any patent so granted on the above-captioned U.S. Application No. 10/635,603 shall be enforceable only for and during such period that the legal title to U.S. Patent

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Petitioner does not disclaim any terminal part of any patent granted on the above-captioned U.S. Application No. 10/635,603 prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,596,801 in the event that U.S. Patent 6,596,801 later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims cancelled by a Reexamination Certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

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